

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL P. LUGER

Appeal No. 2001-1280
Application No. 07/977,163

ON BRIEF

Before COHEN, McQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11-14, 16 and 17. Notwithstanding appellant's statement on page 2 of the brief (Paper No. 31, filed August 16, 1996) that an amendment has not been filed subsequent to the final rejection and the examiner's agreement therewith (answer, page 3), our review of the record indicates that three such amendments (Paper Nos. 24, 27 and 34) were filed. The amendments of Paper Nos. 24 and 34 were not entered (see Paper Nos. 26 and 35). There is no indication that the examiner has

Appeal No. 2001-1280
Application No. 07/977,163

considered the amendment of Paper No. 27, filed May 21, 1996. In any event, inasmuch as no amendment after the final rejection has been approved for entry by the examiner, in the interest of judicial economy, we have decided this appeal based on the assumption that claims 11-17 as presented in Paper No. 19, filed January 3, 1995, are the claims currently pending.¹ Claim 15 stands objected to as being dependent on a rejected base claim and claims 11-14, 16 and 17 stand rejected.

BACKGROUND

The appellant's invention relates to a rearview mirror which provides a driver of a vehicle with general rearview vision as well as a view of the driver's blind-spot area. We direct our attention to the claims in Paper No. 19 in deciding this appeal.²

¹ It is apparent from the examiner's remarks on page 2 of the Office action mailed April 13, 1995 (Paper No. 20) that the examiner has treated the copy of the specification and claims submitted by appellant on January 3, 1995 (Paper No. 19) as a request to substitute the claims (11-17) therein for claims 11-17 previously pending and to substitute the specification for the originally filed specification. The examiner has refused entry of the substitute specification (Paper No. 20, page 2), but the amendment to claims 11-17 has been entered. The record is ambiguous as to whether the examiner treated the amendment of Paper No. 19 as including a request to cancel claims 2 and 3, the only other claims pending prior to the amendment in Paper No. 19, or whether claims 2 and 3 remain withdrawn from consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention.

² Notwithstanding the examiner's statement to the contrary (answer, page 4), the appendix to appellant's brief is replete with errors in reproducing these claims.

Appeal No. 2001-1280
Application No. 07/977,163

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lawson	4,200,359	Apr. 29, 1980
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Weureither	2,331,633	Jun. 6, 1974 ³
(German patent)		

The following rejections are before us for review.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.⁴

Claims 11-14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawson in view of Weureither.

Reference is made to the brief⁵ (Paper No. 31, filed August 16, 1996) and reply brief (Paper No. 37, filed January 15, 1998) and the final rejection (Paper No. 22, mailed October 19, 1995) and examiner's answer (Paper No. 36, mailed November 18, 1997)

³ An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

⁴ Although the examiner has not expressly repeated this rejection in the answer, it is apparent from the examiner's comment in the last paragraph on page 2 of the answer that the § 112, second paragraph, rejection has been maintained by the examiner.

⁵ The August 16, 1996 appeal brief is merely a signed copy of the earlier brief filed January 3, 1996 (Paper No. 25). All references to the brief in this decision are to the August 16, 1996 brief.

for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

With reference to the claims as presented in Paper No. 19, we note the following informalities which, while not of a nature to render the claims indefinite, are deserving of correction in the event of further prosecution.⁶

In claim 11, line 4, "drivers" should be "driver's." In claim 11, line 19, "reflector" should be deleted for consistency with earlier terminology (line 6). In claim 11, line 44, "the" should be inserted before "driver."

In claim 14, line 5, it appears that "two said" should be "said two."

⁶ In this decision, any references to line numbers of claims are with respect to each of the claims themselves (i.e., the first line of any claim would be denoted line 1, etc.), not the line number of the page on which the claim appears.

Appeal No. 2001-1280
Application No. 07/977,163

In claim 15, lines 7-8, "plane mirror surface" should be changed to "plane mirror" to provide clear antecedent for "said third plane mirror" in lines 9 and 12 of claim 15.

In claim 17, line 7, "supports" should be "support."

The indefiniteness rejection

The basis of the examiner's rejection of claim 17 under the second paragraph of 35 U.S.C. § 112 is that the phrase "said second wedge-shaped support structure" in claim 17 lacks antecedent basis (final rejection, page 2). In this regard, we note that claim 17 does recite a "second support structure" in line 4, but that second support structure is not positively recited as being "wedge-shaped." Accordingly, we agree with the examiner that "said second wedge-shaped support structure" lacks antecedent basis in the claim, thereby raising uncertainty as to what recited structure is intended thereby. As appellant has not contested this rejection in either the brief or reply brief⁷, we

⁷ Appellant did attempt to address this rejection in Paper No. 34, filed December 5, 1996, by proposing a new claim 18 to replace claim 17. However, the examiner refused entry of this proposed amendment (Paper No. 35, mailed November 18, 1997).

shall sustain the examiner's rejection of claim 17 under the second paragraph of 35 U.S.C. § 112.⁸

The obviousness rejection

As we understand it, claim 16 is directed to a combination of a rearview mirror, a principal-reflector-surface mirror and a wedge-shaped support structure attached to the rearview mirror for holding the principal-reflector-surface mirror over⁹ the rearview mirror at the proper angle with respect to the rearview mirror so that a portion of the rearview mirror serves as a blind-spot mirror. The claim does not include a vehicle, much less any particular mounting arrangement or location of the rearview mirror to a vehicle.

A "blind-spot," as defined on pages 4-5 of appellant's specification, is the area behind the driver's head, adjacent the vehicle and extending into the adjacent lane, which the driver cannot see in a conventional rear-view mirror. As explained on

⁸ Appellant filed an amendment on May 21, 1996 (Paper No. 27) which, except for an evident inconsistency in claim line references, appears to overcome the antecedent basis problem on which the rejection is grounded. There is no indication that the examiner has considered this amendment. We presume that the examiner will, upon consideration of Paper No. 27, enter the amendment, with the necessary clarifications in line numbering, to overcome the rejection, especially in light of the examiner's indication of allowable subject matter in claim 17.

⁹ Consistent with appellant's underlying disclosure, we understand "over" to mean "upon the surface of" as opposed to "above" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

page 5 of appellant's specification, a blind-spot may be inward (closer to the vehicle relative to the area visible in the conventional rearview mirror) or outward (further from the vehicle relative to the visible area). In accordance with appellant's definition in the specification, a "blind-spot" as used in appellant's claims is sufficiently broad to include inward or outward areas which are not visible to a driver in the conventional rear-view mirror.

While much of the argument in appellant's brief is directed to the orientation of the wedge-shaped support and the principal-reflector-surface mirror relative to the conventional rearview mirror (i.e., the thin edge of the wedge being closer to the vehicle than the wide edge so as to direct the principal-reflector-surface mirror inward toward the vehicle), there is no such limitation in claim 16. Rather, claim 16 merely requires two mirrors, with one of the mirrors supported on the other mirror by means of a wedge-shaped support structure. From our perspective, any orientation of the wedge would fall within the scope of claim 16.

Lawson discloses a side view mirror assembly 1 which is attached through an arm or bracket 2 to the side of a vehicle 3. The mirror assembly includes a housing 4, a flat mirror 5 and a

small, flat mirror 6 attached to the mirror 5 by a wedge-shaped block of pressure sensitive adhesive material 7.

Weureither (Figure 7) discloses a rearview mirror arrangement very similar to that of Lawson comprising a first rearview mirror (surface 19) and a second mirror 27 supported on the first mirror by a wedge-shaped member 18 and double-sided adhesive strips. Weureither does not designate either of the mirrors as principal or blind-spot but, rather, points out that the two mirrors provide two fields of view to the driver (translation, page 8). The rearview mirror as illustrated in Figure 7 is disposed on the driver's side of the vehicle (translation, page 8). Weureither further discloses, as illustrated in Figure 8 and discussed on page 9 of the translation, a rearview mirror disposed on the side of the vehicle opposite the driver's side (i.e., the passenger's side). The only difference between this mirror assembly and the assembly of Figure 7 is that the wedge angle between the two mirrors is smaller in Figure 8.

We recognize, as appellant has, that the mirror 6 is described by Lawson as the "blind-spot" mirror. This is in contrast to appellant's claim 16, which recites that the conventional mirror serves as a "blind-spot mirror" and the

mirror supported thereon serves as a "principal-reflector-surface mirror." Weureither, on the other hand, merely describes the two mirrors as providing two complementary views, rather than designating one as a principal view mirror and the other as a blind-spot mirror. However, we discern no reason why the Lawson mirror assembly lacks the capability to be used such that the mirror 5 is the blind-spot mirror and the mirror 6 supported thereon is the principal-reflector-surface mirror. This would merely involve the driver adjusting the mirror assembly by looking into the mirror 6, with the mirror 5 then providing an auxiliary viewing area not afforded by the mirror 6 and thus serving as a blind-spot mirror. Similarly, the Weureither mirror assembly is fully capable of such use. Thus, in essence, the only difference, if any, between the subject matter of claim 16 and the Lawson or Weureither mirror assembly is in the manner in which the mirror assembly is used.

It is well settled, however, that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It follows then that the designation of the wedge-supported mirror as a "principal-reflector-surface mirror" and the conventional rearview mirror as

a "blind-spot mirror" does not patentably distinguish claim 16 over either Lawson or Weureither (Figures 7 and 8).

Accordingly, we share the examiner's view that the combined teachings of Lawson and Weureither are suggestive of the subject matter of claim 16. The examiner's rejection of claim 16 under 35 U.S.C. § 103 is therefore sustained.

Claim 11 is directed to a combination of a blind-spot mirror supported in a frame and a principal mirror supported on the blind-spot mirror by means of a wedge-shaped support structure. The wedge-shaped support structure and principal mirror are mounted on the blind-spot mirror such that the thin edge of the wedge points generally in an inward direction toward the front and opposite side of the vehicle. Claim 11 is somewhat imprecise, in that the claim does not positively recite a vehicle as part of the claimed invention but does refer to the vehicle to which the rearview mirror is mounted (e.g., lines 7, 14, 50 and 54). Giving the claim its broadest reasonable interpretation¹⁰, for purposes of our review of the rejection before us, we

¹⁰ In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

construe claim 11 as being directed only to a rearview mirror, including a blind-spot mirror, a principal mirror mounted to the blind-spot mirror by means of a wedge-shaped support structure, and a frame immediately supporting the blind-spot mirror, with the wedge-shaped support structure and principal mirror being oriented with respect to the blind-spot mirror such that, when the rearview mirror is mounted to a vehicle, the thin edge of the wedge points inward toward the vehicle. It is also worthy of note that claim 11 is not limited to a rearview mirror for mounting on the driver's side of a vehicle.

Consistent with our discussion, supra, the designation of the wedge-supported mirror as the principal mirror and the mirror supporting the wedge-shaped support structure and principal mirror as the blind-spot mirror distinguishes the subject matter of claim 11 from Lawson's mirror assembly, if at all, only in the manner of intended use of the mirror assembly. Such a distinction, as also mentioned above, cannot be relied upon to support the patentability of the claimed product over the prior art product.

With regard to the limitation in claim 11 that the thin edge of the wedge point inward toward the front and opposite side of the vehicle when mounted to a vehicle, we note that the driver's

side mirror arrangement disclosed and illustrated by Lawson includes a wedge-shaped support having its thin edge pointing away from the vehicle when the mirror assembly is mounted to the driver's side of the vehicle. However, Lawson points out in column 2, lines 38-44, that

the "blind-spot" mirror can be associated with the side view mirror at the passenger side. In this instance the mirror may be somewhat larger in area and the angularity of the block 7 may be slightly different, depending upon the vehicle, to position the small mirror at the desired angle to eliminate the blind spot.

Further, Weureither (Figure 8; translation, page 9) teaches that the thin edge of the wedge of such a mirror points to the left (i.e., inward toward the vehicle), albeit forming a shallower angle between the two mirrors, when mounted on the passenger's side of the vehicle.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a prima facie case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed

combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The combined teachings of Lawson and Weureither would have suggested to one skilled in the art at the time of appellant's invention a rearview mirror for mounting to the passenger's side of a vehicle, the rearview mirror having a first mirror supported by a frame adapted for mounting to the vehicle and a second mirror mounted to the first mirror by means of a wedge-shaped support structure, with the thin edge of the wedge pointing inward toward the opposite side of the vehicle when the rearview mirror is mounted on the passenger's side of the vehicle. Thus, as appellant's claim 11 is not limited to a driver's side rearview mirror, we perceive no error in the examiner's determination that the teachings of Lawson and Weureither are sufficient to establish that the subject matter of claim 11 would have been obvious to one of ordinary skill in the art at the time of appellant's invention.

Appellant's argument on page 11 of the brief with regard to the age of the references is not well taken, as it is well established that the mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem. In re Wright, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977); In re Neal, 481 F.2d 1346, 1347, 179 USPQ 56, 57 (CCPA 1973); In re McGuire, 416 F.2d 1322, 1327, 163 USPQ 417, 421 (CCPA 1969), cert. denied, 397 U.S. 989 (1970).

Accordingly, we shall sustain the examiner's rejection of claim 11 as being unpatentable over Lawson in view of Weureither. We shall also sustain the rejection of dependent claims 12-14 as being unpatentable over Lawson in view of Weureither since appellant has not specifically argued separately the patentability of these claims apart from claim 11. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). See also In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

CONCLUSION

Appeal No. 2001-1280
Application No. 07/977,163

To summarize, the decision of the examiner to reject claim 17 under the second paragraph of 35 U.S.C. § 112 and claims 11-14 and 16 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 2001-1280
Application No. 07/977,163

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